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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,720	01/07/2004	DANIEL SUIA	FP2084	1719
43149 7590 12/07/2007 DANIEL SUIA JL. WALET PERMAI 4/33 PANTAI INDAH KAPUK, JAKARTA, 14470 INDONESIA			EXAMINER OBEID, MAMON A	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 12/07/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/707,720

Applicant(s)

SUISA, DANIEL

Examiner

Mamon Obeid

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

1. This is in reply to application filed on Jan 07, 2004.
2. Claims 1-32 are currently pending and have been examined.

### ***Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C 121:
  - I. Claims 1-31, drawn to a system, classified in class 705, subclass 58.
  - II. Claim 32, drawn to a method, classified in class 705, subclass 80.
4. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case group I is not patentably distinct from group II. A restriction is improper at this time. However, should Applicant amend any claims such that group I becomes patentably distinct from group II, this restriction will be implemented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1- 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Its unclear whether Applicant is reciting an apparatus, system or means plus function. Please construct the claim to clearly define your system. For examination purposes, the Examiner interprets claims 1-31 as claims directed to a system only.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
8. Claims 1-18, 20-23, 25 and 27-32 are rejected under 35 U.S.C. 102(b) as being anticipated by White (U.S Patent No. 4,630,201).
9. **As per claims 1 and 32:** White discloses the following limitations:
  - *an issuer apparatus for issuing a transaction code to a customer (see at least column 3, lines 19-36) and storing the issued transaction code in a database customer (see at least column 6, lines 32-44);*

- *a transaction apparatus for associating the transaction code with a document to perform a transaction and for performing the transaction using the document with the associated transaction code (see at least column 5, lines 40-49); and*
  - *a verification means of the issuer apparatus for verifying the transaction by performing a comparison between the issued transaction code stored in the database and the transaction code associated with the document (see at least column 3, lines 36-46) , the issuer apparatus modifying the transaction code in the database after positive verification of the transaction (if a customer decides to cancel an issued check, the customer has to supply the bank with information such as, the check number, check amount and security code. When the customer is verified, the transaction is deleted or deactivated, (see at least column 8, lines 24-31 and column 7, line 60-column 8, line 9).*
10. **As per claim 2:** White further discloses *wherein the transaction apparatus is a portable handheld device comprising a display module and transaction module (see at least column4, lines 51-62 and figure 1).*
11. **As per claim 3:** White further discloses the following limitations:

- *wherein the transaction module includes: a transaction code storage means for storing issued transaction codes (see at least column 4, lines 51-62 and figure 1); and*
  - *a signature generation means for generating a document signature by encoding the transaction code along with document data required to be associated with the document, and wherein the transaction code and the document signature are then associated with the document (the check number and the associated random number are combined/encoded with the check amount to generate a security code/ signature, said security code /signature is printed/ handwritten on the check, (see at least column 3, lines 27-46);*
  - *a data indicator associated with the document and indicating which of the document data is used to generate the document signature ( see at least column 7, line 60- column 8, line 23).*
12. **As per claim 4:** *White further discloses wherein the transaction apparatus includes a printer for printing the transaction code and the document signature onto the document (see at least column 3, lines 27-46).*
13. **As per claim 5:** *White further discloses wherein the transaction codes are unique for each particular type of transaction performed by a particular customer*

(After a transaction code/ check number is used, it's flagged/deactivated so it may not be used again, (see at least column 8, lines 10-23).

14. **As per claim 6:** White further discloses *wherein the transaction codes are consecutive* (see at least column 3, lines 19-26).
15. **As per claims 7, 8, 11, 16 and 17:** White further discloses *wherein the document is a hard copy document* (see at least column 3, lines 36-46).
16. **As per claims 9 and 10:** White further discloses *wherein the document is a piece of paper without customer specific information printed thereon*. White discloses a check that does not include customer specific information such as transaction/check number, transaction/check amount and security code, (see at least column 3, lines 27- 35 and column 5, and lines 36-49).
17. **As per claim 12:** White further discloses *wherein the transaction code and document signature are copied by the customer from the display module and written on the piece of paper changing the piece of paper into a document corresponding to the particular customer* (see at least column 3, lines 27- 46 and column 7, lines 42-59).

18. **As per claim 13:** White further discloses *wherein the transaction apparatus is a portable handheld device comprising: a transaction code storage means for storing issued transaction codes; a signature generation means for generating the document signature; and a printer for printing the transaction code and the document signature onto the piece of paper thereby changing the piece of paper into a document corresponding to the particular customer (see at least figure 1 and related text).*
19. **As per claim 14:** White further discloses *wherein the transaction code is a check number (see at least column 3, lines 19- 26).*
20. **As per claim 15:** White discloses *wherein the transaction code is a check number (see at least column 3, lines 19- 26).*
21. **As per claim 18:** White further discloses *a display module for displaying pre stored data including a transaction code and pre stored data selected from the set consisting of: account number, account name, and routing number (see at least column 7, lines 42-47); and the display module also displaying a prompt for the customer to input indicated information selected from the set consisting of: date, payee and amount (see at least column 7, lines 1-15).*



22. **As per claim 20:** White further discloses *wherein the issuer apparatus modifies the transaction code in the database after verifying the transaction by removing the transaction code from the database or by flagging the transaction code in the database (see at least column 8, lines 24-31).*
23. **As per claim 21:** White further discloses *wherein the issuer apparatus is associated with an issuer bank (see at least column 2, lines 4-20 and figure 1).*
24. **As per claims 22, 23 and 25:** White further discloses *a payee apparatus associated with a payee for receiving the document with the associated transaction code from the transaction apparatus and for forwarding the document to the issuer bank (see at least column 3, lines 36- 46) and column 8, lines 10-31).*
25. **As per claims 27:** White further discloses *wherein the issuer apparatus is associated with an issuer bank and the document is a fund transfer request to the issuer bank (see at least column 8, lines 32- 50).*
26. **As per claims 28 and 29:** White further discloses *wherein the database is a database of the issuer apparatus (see at least figure 1 and related text).*

27. **As per claim 30:** White further discloses *wherein the issuer apparatus generates the transaction code by applying a mathematical formula to a reference code and wherein the issuer apparatus stores the reference code in the database of the issuer apparatus without storing the issued transaction code in the database of the issuer apparatus* (see at least column 3, lines 19- 26 and column 3, lines 65- column 4, lines 16).

***Claim Rejections - 35 USC § 103***

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 19, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of Official Notice.

30. **As per claim 19:** White discloses all the limitations of claim 1 shown above. White does not disclose *wherein the issuer apparatus issues the transaction code to the customer via SMS or MMS*. However, the examiner takes Official Notice that transmitting transaction codes and password via SMS or MMS is old and well known in the art to ensure that only the specified recipient receives the transaction code or password.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify White's teachings to include the step of transmitting the transaction codes via SMS or MMS to increase the security of the transaction codes by sending them directly to the intended recipient device.

31. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of Goeller et al., (US Patent Application Publication No. 2002/0178112 A1).

32. **As per claim 24:** White discloses forwarding the check to the bank and withdrawing cash or travelers check at an ATM (see at least column 8, lines 10-24 and column 8, lines 32- 50).). White does not explicitly disclose *wherein the payee apparatus forwards the document to the issuer bank by clearing the document through an ATM machine by manually entering at least part of the transaction data into the ATM machine*. However, Goeller discloses depositing a check using an ATM (see at least paragraph [0094]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify White's teachings to include the step of depositing a check at an ATM to initiate an online debit request instead of moving or forwarding physical checks between parties, this speeds up the process and makes it convenient for all parties (see in Goeller at least paragraph [0096]).

33. Claims 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of Willeby (US Patent Application Publication No. 2005/0085931 A1).

34. **As per claim 26:** White further discloses authenticating the check (see at least column 7, lines 60-66). White does not disclose *wherein the clearing includes authenticating the identity of the payee*. However, Willeby discloses authenticating the identity of the payee (see at least paragraph [0022]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify White's teachings to include the step of verifying the identity of the payee to is to prevent fraudulent use or theft of bank account information for transactions occurring over the Internet (see in Willeby at least paragraph [0045]).

35. Although Applicant(s) use "means for" in the claim(s) (e.g. claims 31-35), it is the Examiner's position that the "means for" phrase(s) do not invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of "means for" from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6<sup>th</sup> paragraph should not be invoked.

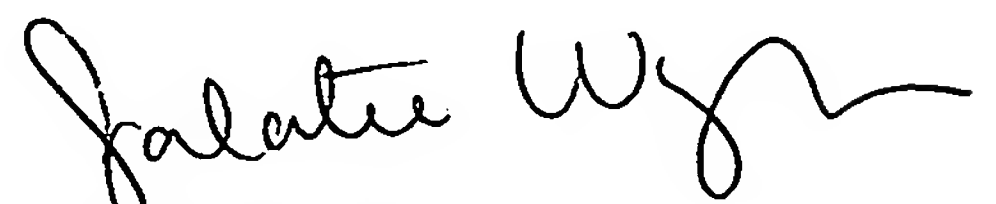
36. Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6<sup>th</sup> paragraph, the "means for" phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6<sup>th</sup>*, (see Federal Register Vol. 65, No 120, June 21, 2000).
37. Failure by Applicant(s) in their next response to also address the 35 U.S.C. 112 6<sup>th</sup> paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112 6<sup>th</sup> paragraph applies to all examined claims currently pending.
38. In light of applicant's choice to pursue product claims, Applicants are reminded that functional recitation(s) using the word and/ or phrases "for", "adapted to" or other functional language (e.g. claim 1 recites "*issuer apparatus for issuing a transaction code to a customer and storing the issued transaction code in a database*") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language (see e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401,

404(Fed. Cir. 1983, which states that although all the limitations must be considered, not all limitations are entitled to patentable weight). To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to distinguish the claimed product from the prior art. If the prior art structure is capable to performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP § § 31.06 II (c.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

39. ***Examiner's Note:*** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mamon Obeid whose telephone number is (571) 270-1813. The examiner can normally be reached on Mon-Fri 9:30 AM- 6:00 PM.
41. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid  
Examiner  
Art Unit: 3621  
December 6, 2007

  
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